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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,007

05/02/2007

Mitsuharu Miwa

46884-5479

7737

55694 7590 04/16/2009  
DRINKER BIDDLE & REATH (DC)  
1500 K STREET, N.W.  
SUITE 1100  
WASHINGTON, DC 20005-1209

EXAMINER

BRUTUS, JOEL F

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

04/16/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,007	<b>Applicant(s)</b> MIWA ET AL.	
	<b>Examiner</b> JOEL F. BRUTUS	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/2008, 10/30/2007, 5/2/2007, 5/19/2006</u> .              | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11,629,471. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

Regarding claim 1, co-pending claim 1 teaches all other limitations.

The co-pending claim doesn't teach adjusting means.

However, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the examined claim by adding an adjusting means; for the purpose of having the capability of modify the image contrast, size etc... to a desired parameter.

Regarding claims 1-5, they are rejected because they depend on a rejected claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi (Pub. No.: US 2002/0013531).

Regarding claims 1-6, Hayashi teaches a method and system by which sentinel lymph node is detected using a fluorescent colorant that is injected near the tumor and project a stimulating light onto the area being examined [see abstract] is pertinent to the claimed invention. Hayashi further teaches a sentinel lymph node detection system and according to the invention a near infrared fluorescent colorant indocyanine green is locally injected in advance into the vicinity of a tumor [see 0059]; and the fluorescent light emitted from the area of tissue under examination upon irradiation thereof by stimulating light is observed by use of a goggle type observation unit and detection of the sentinel lymph node is performed [see 0059].

Hayashi teaches the system comprises a fluorescent lamp, a stimulating light projecting unit which provided with a light source for producing fluorescent image observation using near infrared stimulating light; [see 0060]; the lamp emits white light as illuminating light composed of visible light [see 0061]; the stimulating light is provide with a semiconductor laser for producing stimulating light having a wavelength of 790 nm and a light source driver [see 0062]. The observation unit comprises an objective lens, a near infrared cutoff filter, a half mirror, an eyepiece [see 0063] (eyepieces are made to be mounted on a head portion of an observer). Hayashi teaches a near infrared cutoff filter light having a wavelength of 700 nm or larger and another near

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infrared cutoff filter cuts off light having a wavelength of 820 nm or smaller [see 0064]; a photographing unit (image pick up means) [see 0080-84]; A/D and D/A conversion circuits [see 0085], RGB decoder [see 0095-96], signal output from near infrared use a CCD is subjected to blanking, amplifying, double sampling clamping etc... are use as to adjust a color of and a contrast (emphasis added). A monitor for displaying images [see 0100].

Regarding claim 6, Hayashi also teaches observation means consisting of a variety of optical means, a normal image optical path, and optical system for focusing [see 0078]. The sentinel lymph node is implemented in laparoscope comprises an insertion portion, an illumination unit, a photographing unit [see 0080-84]; the insertion portion comprises a light guide [see 0082].

Regarding claim 3, Hayashi teaches fluorescent image forming unit for performing the image processing to display near infrared image as a stepped image corresponding to the degree of strength of the light [see 0080].

Regarding claim 5, Hayashi teaches a fluorescent image memory for saving the digitized color image signal, a D/A conversion circuit, A/D conversion circuit [see 0085, 0094-996].

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOEL F. BRUTUS whose telephone number is

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(571)270-3847. The examiner can normally be reached on Mon-Fri 7:30 AM to 5:00 PM (Off alternative Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F. B./  
Examiner, Art Unit 3768

/Long V Le/  
Supervisory Patent Examiner, Art Unit 3768